

**REMARKS**

Claim 5 is amended to correct a typographical error. Applicants assert that the amendment of claim 5 does not raise any new issue. Applicants respectfully request that the amendment to claim 5 be entered to place the claims in better condition for appeal.

The Examiner rejected claims 1-4 and 8 under 35 U.S.C. §102(b) as allegedly being anticipated by Robinson et al.

The Examiner rejected claims 7 and 9-10 under 35 U.S.C. §103(a) as allegedly being unpatentable over Robinson et al. in view of Musk et al., US 6,148,260.

The Examiner rejected claims 5-6, 11, 13-15, 18-19 and 20-30 under 35 U.S.C. §103(a) as allegedly being unpatentable over Robinson et al. in view of Moran et al., US 6,326,946 and Thompson et al., US 5,986,401.

The Examiner rejected claims 12 and 16-17 under 35 U.S.C. §103(a) as allegedly being unpatentable over Robinson et al. in view of Moran et al., US 6,326,946 and Thompson et al., US 5,986,401 and further in view of Musk et al., US 6,148,260.

Applicants respectfully traverse the §102 and §103 rejections with the following arguments.

**35 U.S.C. §102(b)**

The Examiner rejected claims 1-4 and 8 under 35 U.S.C. §102(b) as allegedly being anticipated by Robinson et al.

Applicants respectfully contend that Robinson does not anticipate claim 1, because Robinson does not teach each and every feature of claim 1.

As an example of why Robinson does not teach each and every feature of claim 1, Robinson does not teach the feature: "encoding the absolute coordinates in the hyperlink". The Examiner alleges that Robinson teaches that the interactor has absolute coordinates. However, Robinson does not teach anywhere that the coordinates of the interactor are encoded in the hyperlink to the physical document. Applicants contend that the coordinates of the interactor can be stored anywhere so long as the coordinates can be accessed and the coordinates of the interactor are therefore not inherently stored in the hyperlink. In fact, Robinson specifically teaches in section 4.4: "The page's identifier and the co-ordinates of the link are looked up in the registry to yield the appropriate activity and the results projected back onto the desk" (emphasis added), which proves that Robinson does not teach that the coordinates of the interactor are encoded in the hyperlink. In other words, storing the coordinates in the registry does not imply storing the coordinates in the hyperlink. The coordinates of the interactor could be stored anywhere in the registry not within the hyperlink and still be accessible.

Based on the preceding arguments, Applicants respectfully maintain that Robinson does not anticipate claim 1, and that claim 1 is in condition for allowance. Since claims 2-4 and 8 depend from claim 1, Applicants contend that claims 2-4 and 8 are likewise in condition for allowance.

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In addition with respect to claim 2, Applicants respectfully contend that Robinson does not teach the feature: "wherein the step of encoding further includes the step of encoding an address of a second electronic document in the hyperlink". I

The Examiner alleges: "Robinson discloses encoding an address of a second electronic document in the hyperlink in sections 3, 4, 4.1, and 4.4. The electronic document paired with the paper document contains hyperlinks which point to other electronic resources such as other electronic documents."

In response, Applicants request that the Examiner quote specific language in Robinson that supports the preceding allegation by the Examiner. Applicants contend that no such language exists in Robinson.

In addition with respect to claim 4, Applicants respectfully contend that Robinson does not teach the feature: "storing the absolute coordinates in a table".

The Examiner argues: "Robinson discloses storing the absolute coordinates in a table in sections 3 and 4.4. The each page representation in the registry maintains the associations between the coordinates and the interactors, or reference items, on the page."

In response, Applicants contend that the coordinates are stored in the registry (see Robinson, section 4.4). However, Robinson does not teach that the coordinates are stored in a table. Applicants contend that a table is only one storage format of a multiplicity of storage format that could be used to store data. Applicants have searched the text of Robinson and have found that the word "table" does not appear anywhere within the text of Robinson. Applicants request that the Examiner identify a specific quote from Robinson that allegedly teaches that the

coordinates are stored in a table.

In addition with respect to claim 8, Applicants respectfully contend that Robinson does not teach the feature: "the electronic document is a hyper text markup language document; and the hyperlink uses syntactic conventions of hyper text markup language". A search of the text of Robinson shows that Robinson does not teach "syntactic conventions of hyper text markup language" and never even mentions "hyper text markup language". Applicants request that the Examiner identify a specific quote from Robinson that allegedly teaches the preceding feature of claim 8.

**35 U.S.C. §103(a): Claims 7 and 9-10**

The Examiner rejected claims 7 and 9-10 under 35 U.S.C. §103(a) as allegedly being unpatentable over Robinson et al. in view of Musk et al., US 6,148,260.

Since claims 7 and 9-10 depend from claim 1, which Applicants have argued *supra* to not be unpatentable over Robinson in view of Moran and Thompson under 35 U.S.C. §103(a), Applicants maintain that claims 7 and 9-10 are likewise not unpatentable over Robinson in view of Moran and Thompson in further view of Musk under 35 U.S.C. §103(a).

For claims 7 and 9-10, the Examiner alleges that it is obvious to modify Robinson by alleged teachings of Musk. However, the Examiner offers reasons to modify Robinson by Musk that are not taught in the prior art but are instead created by the Examiner.

In other words, the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Robinson by the alleged teaching of Musk in relation to claims 7 and 9-10. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art suggested the desirability of the modification."). The Examiner has not made any showing of

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where the prior art suggests the reasons argued by the Examiner for modifying Robinson with Musk.

Applicants further note that anybody with a creative imagination can invent a reason to allege obviousness. However, inventing a reason that is not suggested by the prior art is not legally persuasive for demonstrating obviousness.

Accordingly, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claims 7 and 9-10.

**35 U.S.C. §103(a): Claims 5-6, 11, 13-15, 18-19 and 20-30**

The Examiner rejected claims 5-6, 11, 13-15, 18-19 and 20-30 under 35 U.S.C. §103(a) as allegedly being unpatentable over Robinson et al. in view of Moran et al., US 6,326,946 and Thompson et al., US 5,986,401.

**Claims 5-6, 18-19, 20-21, and 24-30**

Applicants respectfully contend that Robinson in view of Moran and Thompson does not teach or suggest the feature of claims 5-6, 11, 13-15, 18-19 and 20-30: "aligning an opto-touch foil on the physical document" and "computing, from the absolute coordinates, foil coordinates on the opto-touch foil corresponding to a position on the physical document".

With respect to claims 5-6, 11, 13-15, 18-19 and 20-30, the Examiner argues: "Robinson does not teach computing foil coordinates because Robinson uses a camera location system instead of a touch foil system. Moran teaches use of a touch foil system in col. 6 lines 13-19 and teaches wherein the touch foil is used to associate a service with a particular physical location in col. 2 line 50 - col. 3 line 3."

In response, Applicants point out that if the Examiner is assuming the "pressure sensitive grid" in Moran, col. 6, lines 15-19 to be a touch foil (which is a highly questionable assumption to begin with), then there is no motivation to combine Moran with Robinson, because Moran uses the pressure sensitive grid only for "attaching a document to a surface" which is irrelevant to Robinson's digital desk.

Moreover, Applicants respectfully contend that there is absolutely no disclosure of use of a touch foil system in Moran, col. 2, line 50 - col. 3, line 3 to associate a service with a particular

physical location, as alleged by the Examiner. Applicants request that the Examiner provide a specific quote from Moran, col. 2, line 50 - col. 3, line 3 that allegedly teaches use of a touch foil to associate a service with a particular physical location.

In addition with respect to claims 5-6, 11, 13-15, 18-19 and 20-30, the Examiner argues: "It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Moran and Thompson into Robinson to have created the claimed invention. It would have been obvious and desirable to have used the touch foil of Moran and the TOLED of Thompson to have improved Robinson so that the position could have been sensed and feedback presented to the user without the user's hand or input pen interfering with either the sight of the input camera or the projection of the feedback projector of Robinson."

In response, Applicants note that the opto-touch foil is aligned on the physical document (as required by claims 5-6, 11, 13-15, 18-19 and 20-30) and the touch-pad doesn't activate anything unless the touch pad is touched or pressed. Therefore, the user's hand or pressing device will be in the space under Robinson's camera in order to touch or press the touch pad in order to activate the touch pad. Therefore, the Examiner's reason for modifying Robinson by Moran and Thompson appears to be based on an incorrect understanding of how a touch pad is activated.

Moreover with respect to claims 5-6, 11, 13-15, 18-19 and 20-30, the Examiner's argument for modifying Robinson by Moran and Thompson is not motivated by any suggestion in the prior art, but rather has instead been created by the Examiner, and is thus not legally persuasive.

Also with respect to claims 5-6, 11, 13-15, 18-19 and 20-30, the Examiner has not even addressed why it is allegedly obvious to modify Robinson to incorporate the optical aspect of the opto-touch foil recited in claims 5-6, 11, 13-15, 18-19 and 20-30.



Accordingly, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claims 5-6, 11, 13-15, 18-19 and 20-30.

In addition with respect to claim 6, Applicants respectfully contend that the Examiner has made no argument, and has not even alleged that Robinson in view of Moran and Thompson argument that Robinson teaches or suggests "storing the foil coordinates in a table" (emphasis added). Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 6.

In addition with respect to claims 5, 18 and 26, Applicants respectfully contend that Robinson in view of Moran and Thompson does not teach or suggest the feature: "computing, from the absolute coordinates, foil coordinates on the opto-touch foil corresponding to a position on the physical document" (for claim 18 and similar language in claims 5 and 26).

The Examiner argues: "Robinson teaches computing camera coordinates from the absolute coordinates of the referenced item in sections 3 and 4.4. Robinson does not teach computing foil coordinates because Robinson uses a camera location system instead of a touch foil system. Moran teaches use of a touch foil system in col. 6 lines 13-19 and teaches wherein the touch foil is used to associate a service with a particular physical location in col. 2 line 50 - col. 3 line 3."

In response, Applicants maintain that Moran likewise does not teach or suggest "computing, from the absolute coordinates, foil coordinates on the opto-touch foil corresponding to a position on the physical document". Moran doesn't teach anything about a touch foil in col. 2 line 50 - col.

3 line 3, and Moran doesn't anywhere teach computing foil coordinate from the absolute coordinates.

Accordingly, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claims 5, 18, and 26.

In addition with respect to claim 19 and 28, Applicants respectfully contend that Robinson in view of Moran and Thompson does not teach or suggest the feature: "storing the absolute coordinates in a table; and storing the foil coordinates **in the table**" (emphasis added).

The Examiner argues: "Robinson discloses storing the absolute coordinates in a table in sections 3 and 4.4. The each page representation in the registry maintains the associations between the coordinates and the interactors, or reference items, on the page."

In response, Applicants contend that the coordinates are stored in the registry (see Robinson, section 4.4). However, Robinson does not teach that the coordinates are stored in a table. Applicants contend that a table is only one storage format of a multiplicity of storage format that could be used to store data. Applicants have searched the text of Robinson and have found that the word "table" does not appear anywhere within the text of Robinson. Applicants challenge the Examiner to identify a specific quote from Robinson that allegedly teaches that the absolute coordinates and the foil coordinates are stored in a table.

Moreover, Robinson does not teach that foil coordinates (or coordinates corresponding to foil coordinates) are stored anywhere. Logically, if the absolute coordinates are known, and if algorithm exists to calculate foil coordinates (or coordinates corresponding to foil coordinates), then there is no need to ever store the foil coordinates (or coordinates corresponding to foil

coordinates) anywhere.

Accordingly, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claims 19 and 28.

In addition with respect to claims 20 and 29, Applicants respectfully contend that Robinson in view of Moran and Thompson does not teach or suggest the feature: "sending the foil coordinates to the opto-touch foil that optically highlights a position upon the opto-touch foil responsive to the foil coordinates".

The Examiner has not addressed the feature: "sending the foil coordinates to the opto-touch foil". Moreover, the Examiner has not even addressed why it is allegedly obvious to modify Robinson to incorporate the optical aspect of the opto-touch foil to optically highlight a position upon the opto-touch foil responsive to the foil coordinates.

Accordingly, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation

In addition with respect to claims 21 and 30, Applicants respectfully contend that Robinson in view of Moran and Thompson does not teach or suggest the feature: "determining calibration foil coordinates of a point pressed on the opto-touch foil, which point corresponds to the referenced item; and calibrating the opto-touch foil using the calibration foil coordinates".

The Examiner alleges that Robinson, section 4.2 teaches the preceding feature of claims 21 and 30.

In response, Applicants respectfully contend that Robinson, section 4.2 does not even come

close to teaching the preceding feature of claims 21 and 30.

Accordingly, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claims 21 and 30.

In addition with respect to claims 22, 24, 25 and 27, Applicants respectfully contend that Robinson in view of Moran and Thompson does not teach or suggest the feature: "the light emitting foil is disposed between the touch foil and the physical document".

The Examiner has not even addressed the preceding feature of claims 22, 24, 25 and 27.

Accordingly, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claims 22, 24, 25 and 27.

In addition with respect to claims 23, Applicants respectfully contend that Robinson in view of Moran and Thompson does not teach or suggest the feature: "wherein the encoded absolute coordinates identify a location, on an opto-touch foil aligned on the physical document, associated with the reference item".

The Examiner argues: "Moran teaches a touch foil for identifying a location selected by a user's touch in col. 2 line 50 - col. 3, line 3 and col. 6 lines 13-19".

The Examiner appears to be basing the Examiner's argument on the following teaching in Moran, col. 6, lines 15-17: "a pressure sensitive grid underlying a document can be used to localize position of a pin attaching a document to the surface 32". Applicants do not find the preceding quote persuasive and there is nothing else in Moran relating to a touch foil. In fact, Applicants question any assertion by the Examiner that a pressure sensitive grid is a touch foil.

Accordingly, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 23.

Claims 11 and 13-15

With respect to claim 11, Applicants respectfully contend that the Examiner's argument that Robinson teaches "within the hyperlink, encoded absolute coordinates of the referenced item" is not persuasive.

The Examiner alleges that Robinson teaches that the interactor has absolute coordinates. However, Robinson does not teach anywhere that the coordinates of the interactor are encoded in the hyperlink to the physical document. Applicants contend that the coordinates of the interactor can be stored anywhere so long as the coordinates can be accessed and the coordinates of the interactor are therefore not inherently stored in the hyperlink. In fact, Robinson specifically teaches in section 4.4: "The page's identifier and the co-ordinates of the link are looked up in the registry to yield the appropriate activity and the results projected back onto the desk" (emphasis added), which proves that Robinson does not teach that the coordinates of the interactor are encoded in the hyperlink. In other words, storing the coordinates in the registry does not imply storing the coordinates in the hyperlink. The coordinates of the interactor could be stored anywhere in the registry not within the hyperlink and still be accessible.

Based on the preceding arguments, Applicants respectfully maintain that Robinson does not anticipate claim 11, and that claim 11 is in condition for allowance. Since claims 13-15 depend from claim 11, Applicants contend that claims 13-15 are likewise in condition for allowance.

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In addition with respect to claim 13, Applicants respectfully contend that the Examiner's argument that Robinson teaches "wherein the electronic document is a hyper text markup language document, and the hyperlink uses syntactic convention of hyper text markup language" is not persuasive. A search of the text of Robinson shows that Robinson does not teach "syntactic convention of hyper text markup language" and never even mentions "hyper text markup language". Applicants request that the Examiner provide a specific quote from Robinson that allegedly teaches the preceding feature of claim 13.

Accordingly, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 13.

In addition with respect to claim 14, Applicants respectfully contend that the Examiner's argument that Robinson teaches "wherein the hyperlink includes an address of a second electronic document" is not persuasive.

The Examiner alleges: "Robinson discloses encoding an address of a second electronic document in the hyperlink in sections 3, 4, 4.1, and 4.4. The electronic document paired with the paper document contains hyperlinks which point to other electronic resources such as other electronic documents."

In response, Applicants request that the Examiner quote specific language in Robinson that supports the preceding allegation by the Examiner. Applicants contend that no such language exists in Robinson.

Accordingly, Applicants respectfully contend that the Examiner has not established a *prima*

*facie* case of obviousness in relation to claim 14.

35 U.S.C. §103(a): Claims 12 and 16-17

The Examiner rejected claims 12 and 16-17 under 35 U.S.C. §103(a) as allegedly being unpatentable over Robinson et al. in view of Moran et al., US 6,326,946 and Thompson et al., US 5,986,401 and further in view of Musk et al., US 6,148,260.

Since claims 12 and 16-17 depend from claim 11, which Applicants have argued *supra* to not be unpatentable over Robinson in view of Moran and Thompson under 35 U.S.C. §103(a), Applicants maintain that claims 12 and 16-17 are likewise not unpatentable over Robinson in view of Moran and Thompson in further view of Musk under 35 U.S.C. §103(a).

For claims 12 and 16-17, the Examiner alleges that it is obvious to modify Robinson by alleged teachings of Musk. However, the Examiner offers reasons to modify Robinson by Musk that are not taught in the prior art but are instead created by the Examiner.

In other words, the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Robinson by the alleged teaching of Musk in relation to claims 12 and 16-17. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. v. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art



suggested the desirability of the modification."). The Examiner has not made any showing of where the prior art suggests the reasons argued by the Examiner for modifying Robinson with Musk.

Accordingly, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claims 12 and 16-17.

**CONCLUSION**

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0457.

Date: 06/17/2005

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